

## **REMARKS**

### **I. Background**

The present Amendment is in response to the Office Action mailed October 11, 2006. Since claims 13-19, 21, and 22 have been previously withdrawn, claims 1-12, 20, and 23 were pending in the application for consideration at the time of the mailing of the Office Action. Claims 1, 13, 18, 20, and 23 are currently amended. Claims 1-12, 20, and 23 are still pending for consideration.

Reconsideration of the application is respectfully requested in view of the above amendments to the claims and the following remarks. For the Examiner's convenience and reference, Applicant's remarks are presented in the order in which the corresponding issues were raised in the Office Action.

Please note that the following remarks are not intended to be an exhaustive enumeration of the distinctions between any cited references and the claimed invention. Rather, the distinctions identified and discussed below are presented solely by way of example to illustrate some of the differences between the claimed invention and the cited references. In addition, Applicant requests that the Examiner carefully review any references discussed below to ensure that Applicant's understanding and discussion of the references, if any, is consistent with the Examiner's understanding.

### **II. Proposed Claim Amendments**

Please amend the claims in the manner indicated above, where an underline represents new text, and strikeouts are used to indicate deleted text. The amendments to claims 1, 13, 18, 20, and 23 have been made to place the claims in condition for allowance, and are fully supported by the application as originally filed. Thus, Applicant submits that the amendments to the claims do not introduce new matter and entry thereof is respectfully requested.

### III. Rejection on the Merits

#### A. Rejections Under 35 U.S.C. § 103

The Office Action has rejected claims 1-12, 20, and 23 under 35 U.S.C. § 103(b) as being unpatentable over *Su et al.* (U.S. 2002/0068102) in view of *Fischer et al.* (U.S. 5,433,965) or *Downton et al.* (U.S. 5,411,755). Applicant respectfully traverses because the Office Action has not established a *prima facie* case of obviousness. Additionally, Applicant respectfully objects to the characterization of *Fischer* and *Downton* provided in the Office Action, which fails to acknowledge that Luo Han Guo itself has bad odor and taste, and storage problems.

According to the applicable law, a claimed invention is unpatentable for obviousness if the differences between it and the prior art "are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art." 35 U.S.C. § 103(a) (2005); *Graham v. John Deere Co.*, 383 U.S. 1, 14 (1966); MPEP 2142. Obviousness is a legal question based on underlying factual determinations including: (1) the scope and content of the prior art, including what that prior art teaches explicitly and inherently; (2) the level of ordinary skill in the prior art; (3) the differences between the claimed invention and the prior art; and (4) objective evidence of nonobviousness. *Graham*, 383 U.S. at 17-18; *In re Dembiczak*, 175 F.3d 994, 998 (Fed. Cir. 1999). It is the initial burden of the PTO to demonstrate a *prima facie* case of obviousness, which requires the PTO to show that the relied upon references teach or suggest all of the limitations of the claims. MPEP 2142 (emphasis added).

According to MPEP section 2143:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)." (emphasis added).

The Office Action alleges that *Su* teaches a dietary supplement that comprises reconstituted noni fruit (*morinda citrifolia*), and can be used to reduce cellular damage within the human body (page 4). Also, the Office Action alleges that *Su* teaches the dietary supplement can include other natural juices, such as blueberry juice concentrate and/or another natural juice concentrate (page 4). Additionally, the Office Action alleges that *Su* teaches the noni fruit can have a foul odor and/or taste when ripe or overripe (page 4). Further, the Office Action alleges that *Su* teaches a method of preparing the dietary supplement where noni fruit "juice and puree are typically blended in a homogeneous blend, after which they are mixed with other ingredients, such as flavorings, sweeteners, nutritional ingredients, botanicals, extracts, and/or colorings" and the "flavorings may include artificial and/or natural flavor or ingredients that contribute palatability," where the sweeteners are taught to include "natural sugars, artificial and high-intensity sweeteners, such as natural sugars derived from corn, sucralose, stevia, and saccharin" (page 4). However, *Su* is completely devoid of teaching or suggesting a dietary supplement that includes "noni fruit, Luo Han Guo in an effective amount to mask flavor and/or scent of the noni fruit, and water." Further, the Office Action indicates that *Su* is completely devoid of teaching or suggesting a method of improving the taste and odor of the noni fruit dietary supplement (page 5). In part, this is because *Su* is completely devoid of teaching or suggesting that the products obtained from the noni fruit utilized in the dietary supplement or that the dietary supplement itself has a bad odor or taste that needs to be masked. As such, *Su* is completely devoid of teaching or suggesting a dietary supplement having the presently claimed composition.

The Office Action alleges that *Fischer* teaches a beverage and sweetening composition comprising Luo Han Guo (serum, puree, or juice), and the Luo Han Guo is used as a sweetening ingredient in place of sugar (page 5; citing col. 1, line 25 through col. 2 line 46); however, the Office Action fails to acknowledge this citation also teaches "Luo Han Guo is seldom used as fresh juice due to the problems of storing it, its unattractive vegetable flavor and its tendency to form off flavors." Also, the Office Action alleges that *Fischer* teaches that Luo Han Guo allows for good tasting, storage-stable beverages and can be used in beverages, such as fruit juices and fruit juice-containing beverages (page 6). Additionally, the Office Action alleges that *Fischer* teaches a reduced calorie flavoring system that has acceptable mouth feel and taste characteristic without off-flavors (page 6). Further, the Office Action alleges that *Fischer* teaches flavoring

agents can be used, which can include raspberry and blueberry (page 6). However, the Office Action fails to acknowledge that the sweetener or sweet juice compositions recited in *Fischer* is produced by "mixing the sweet juice [Luo Han Guo] with a sugar component" and has "from about 40% to about 60% sugars, such as glucose, fructose, and sucrose." Additionally, the Office Action fails to acknowledge that the Luo Han Guo compositions recited in *Fischer* require processing steps to reduce the unfavorable taste and smell (column 6 line 50 through column 10 line 3). Also, *Fischer* is completely devoid of teaching or suggesting a dietary supplement that includes "noni fruit, Luo Han Guo in an effective amount to mask flavor and/or scent of the noni fruit, and water." In part, this is because *Fischer* is devoid of teaching or suggesting a method of improving the taste and odor of the noni fruit dietary supplement by using Luo Han Guo, or that Luo Han Guo can be used to mask flavor and/or scent of anything. As such, *Fischer* is completely devoid of teaching or suggesting a dietary supplement having the presently claimed composition.

The Office Action alleges that *Downton* teaches a sweet juice composition comprising Luo Han Guo made from Luo Han Guo juice so that it does not contain objectionable off-flavors and does not reform substantial quantities of off-flavors during storage (page 7; citing column 2, lines 1-26 and column 3, lines 3-15); however, the Office Action fails to acknowledge this citation also teaches that Luo Han Guo "is seldom used fresh due to the problems of storing it, its unattractive vegetable flavor and its tendency to form off-flavors." Additionally, the Office Action alleges that *Downton* teaches the Luo Han Guo juice can be blended with other fruit juices, such as raspberry fruit juices (page 7; citing column 2, lines 27-30 and column 10, lines 30-50); however, the Office Action fails to acknowledge this citation is devoid of teaching or suggesting that Luo Han Guo juice can be blended with fruit juices that have unfavorable taste or odor or can mask such unfavorable taste or odor. However, the Office Action fails to acknowledge that the Luo Han Guo compositions recited in *Downton* require processing steps to reduce the unfavorable taste and smell (column 3 line 24 through column 9 line 42). Also, *Downton* is completely devoid of teaching or suggesting a dietary supplement that includes "noni fruit, Luo Han Guo in an effective amount to mask flavor and/or scent of the noni fruit, and water." In part, this is because *Downton* is devoid of teaching or suggesting a method of improving the taste and odor of the noni fruit dietary supplement by using Luo Han Guo, or that

Luo Han Guo can be used to mask flavor and/or scent of anything. As such, *Downton* is completely devoid of teaching or suggesting a dietary supplement having the presently claimed composition

#### **1. No Suggestion or Motivation for Combination**

Applicant respectfully asserts that a *prima facie* case of obviousness has not been established. In part, this is because there is no suggestion or motivation arising from *Su* and *Fischer* or *Downton*, alone or in combination, to make such a combination of references. It is known that just because different elements of an invention may be found in different references does not allow for a combination of such references to reconstruct the Applicant's invention. Accordingly, the Court has stated that "[t]he genius of invention is often a combination of known elements which in hindsight seems preordained. To prevent hindsight invalidation of patent claims, the law requires some "teaching, suggestion or reason" to combine cited references. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed. Cir. 1997). Correspondingly, disclosure of a dietary supplement containing noni fruit described in *Su* does not alone provide any motivation or suggestion to combine the dietary supplement or noni fruit with the sweetener or sweet juice composition described in *Fischer* or *Downton*. In part, this is because *Su* is devoid of teaching or suggesting that the products obtained from the noni fruit utilized in the dietary supplement or that the dietary supplement itself has a bad odor or taste that needs to be masked, and neither *Fischer* nor *Downton* teach or suggest that Luo Han Guo can be used to mask a bad odor or taste as alleged in the Office Action.

Nothing in *Su* provides any motivation or suggestion that the products obtained from the noni fruit utilized in the dietary supplement or that the dietary supplement itself has a bad odor or taste that needs to be masked. Additionally, nothing in *Fischer* or *Downton* provides any motivation or suggestion that Luo Han Guo, or products or extracts thereof, can be used to mask a bad odor or taste, which may be due to the fact that the Luo Han Guo has a bad odor and taste itself. Since *Su* does not teach or suggest that the products obtained from the noni fruit utilized in the dietary supplement or that the dietary supplement itself has a bad odor or taste that needs to be masked there is no motivation or suggestion to combine the products obtained from the

noni fruit utilized in the dietary supplement or that the dietary supplement itself with something to mask the odor or taste. Correspondingly, the fact that Luo Han Guo has a bad odor and taste itself that has to be carefully removed under the teachings of *Fischer* and *Downton* does not provide any motivation or suggestion that the sweetener or sweet juice composition having Luo Han Guo can be used to mask the odor or taste of anything, especially the products obtained from the noni fruit utilized in the dietary supplement or that the dietary supplement of *Su*.

## **2. Combination Does Not Teach Each Claim Limitation**

Applicant respectfully asserts that the combination of *Su* and *Fischer* or *Downton* does not teach each and every claim limitation of the presently claimed invention. Specifically, none of *Su* and *Fischer* or *Downton* teaches that a sweetener or sweet juice composition having Luo Han Guo can be used to mask the odor or taste of anything, especially the products obtained from the noni fruit utilized in the dietary supplement or the dietary supplement itself. As such, none of *Su* and *Fischer* or *Downton* teaches or suggests a dietary supplement that includes "noni fruit, Luo Han Guo in an effective amount to mask flavor and/or scent of the noni fruit, and water. Since none of *Su* and *Fischer* or *Downton* teaches or suggests "Luo Han Guo in an effective amount to mask flavor and/or scent of the noni fruit," each and every element of the presently pending claims has not been taught or suggested by the proposed combination of references.

Since there is no suggestion or motivation arising *Su* and *Fischer* or *Downton* to make the proposed combination of references, and the combination of references still does not teach or suggest each and every element of the claims, a *prima facie* case of obviousness has not been established. As such, Applicant respectfully requests the rejection of claims 1-12, 20, and 23 be withdrawn.

## **B. Rejections Under 35 U.S.C. § 103**

The Office Action has rejected claims 1-12, 20, and 23 under 35 U.S.C. § 103(b) as being unpatentable over *Yegorova et al.* (U.S. 6,387,370) in view of *Fischer et al.* (U.S. 5,433,965 or *Downton et al.* (U.S. 5,411,755). Applicant respectfully traverses because the Office Action has not established a *prima facie* case of obviousness. Additionally, Applicant

respectfully objects to the characterization of *Yegorova*, *Fischer*, and *Downton* provided in the Office Action, and the discussion of *Fischer* and *Downton* provided above is incorporated into this remark by reference.

The Office Action alleges that *Yegorova* teaches a composition that includes extracts of noni juice and blueberry extracts (page 9; citing Abstract, column 5, lines 22-26, and column 6, line 66 through column 7, line 10); however, the Office Action fails to acknowledge this citation also teaches that the composition further includes "red wine extract, prune extract, blueberry extract, pomegranate extract, apple extract, and an enzyme mixture." However, *Yegorova* is completely devoid of teaching or suggesting a dietary supplement that includes "noni fruit, Lou Han Guo in an effective amount to mask flavor and/or scent of the noni fruit, and water." Further, the Office Action indicates that *Yegorova* is completely devoid of teaching or suggesting a method of improving the taste and odor of the noni fruit-containing composition (page 5). In part, this is because *Yegorova* is completely devoid of teaching or suggesting that the noni fruit extracts utilized in the composition or that the composition itself has a bad odor or taste that needs to be masked. As such, *Yegorova* is completely devoid of teaching a dietary supplement having the presently claimed composition.

#### **1. No Suggestion or Motivation for Combination**

Applicant respectfully asserts that a *prima facie* case of obviousness has not been established. In part, this is because there is no suggestion or motivation arising from *Yegorova* and *Fischer* or *Downton*, alone or in combination, to make such a combination of references. Accordingly, disclosure of a composition containing noni fruit described in *Yegorova* does not alone provide any motivation or suggestion to combine the noni fruit or composition taught therein with the sweetener or sweet juice composition described in *Fischer* or *Downton*. In part, this is because *Yegorova* is devoid of teaching or suggesting that the products obtained from the noni fruit utilized in the composition or that the composition itself has a bad odor or taste that needs to be masked, and neither *Fischer* nor *Downton* teach or suggest that Luo Han Guo can be used to mask a bad odor or taste as alleged in the Office Action.

Nothing in *Yegorova* provides any motivation or suggestion that the products obtained from the noni fruit utilized in the composition or that the composition itself has a bad odor or

taste that needs to be masked. Additionally, nothing in *Fischer* or *Downton* provides any suggestion or motivation that Luo Han Guo can be used to mask a bad odor or taste, which may be due to the fact that the Luo Han Guo has a bad odor and taste itself. Since *Yegorova* does not teach or suggest that the products obtained from the noni fruit utilized in the composition or that the composition itself has a bad odor or taste that needs to be masked, there is no motivation or suggestion to combine the products obtained from the noni fruit utilized in the composition or that the composition itself with something to mask the odor or taste. Correspondingly, the fact that Luo Han Guo has a bad odor and taste itself that has to be carefully removed under the teachings of *Fischer* and *Downton* does not provide any motivation or suggestion that the sweetener or sweet juice composition having Luo Han Guo can be used to mask the odor or taste of anything, especially the products obtained from the noni fruit utilized in the composition or the composition of *Yegorova*.

## **2. Combination Does Not Teach Each Claim Limitation**

Applicant respectfully asserts that the combination of *Yegorova* and *Fischer* or *Downton* does not teach each and every claim limitation of the presently claimed invention. Specifically, none of *Yegorova* and *Fischer* or *Downton* teaches that a sweetener or sweet juice composition having Luo Han Guo can be used to mask the odor or taste of anything, especially the products obtained from the noni fruit utilized in the composition or the composition itself. As such, none of *Yegorova* and *Fischer* or *Downton* teaches or suggests a dietary supplement that includes "noni fruit, Luo Han Guo in an effective amount to mask flavor and/or scent of the noni fruit, and water. Since none of *Su* and *Fischer* or *Downton* teaches or suggests Luo Han Guo in an effective amount to mask flavor and/or scent of the noni fruit, each and every element of the presently pending claims has not been taught or suggested by the proposed combination of references.

Since there is no suggestion or motivation arising *Yegorova* and *Fischer* or *Downton* to make the proposed combination of references, and the combination of references still does not teach or suggest each and every element of the claims, a *prima facie* case of obviousness has not been established. As such, Applicant respectfully requests the rejection of claims 1-12, 20, and 23 be withdrawn.

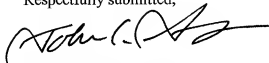


**CONCLUSION**

In view of the foregoing, Applicants respectfully request favorable reconsideration and allowance of the present claims. In the event the Examiner finds any remaining impediment to the prompt allowance of this application which could be clarified by a telephone interview, the Examiner is respectfully requested to contact the undersigned attorney.

Dated this 11 day of January, 2007.

Respectfully submitted,



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